

REMARKS

This submission is in response to the Official Action dated July 10, 2003. Reconsideration of the above identified application, in view of the above amendments and the following remarks, is respectfully requested.

The Examiner has required restriction to one of the following Groups under 35 U.S.C. § 121:

Group I: Claims 1-2, drawn to a chemical compound;

Group II: Claims 3-11, drawn to a process of making a compound by fermentation with a strain *Streptomyces*; and

Group III: Claim 12, drawn to a method of treating tuberculosis.

The Applicants hereby elect, with traverse, to prosecute the claims of Group I (claims 1 and 2) which are directed to a compound.

Although Applicants are making the above election to be fully responsive to Restriction Requirement, Applicants respectfully traverse the Requirement and reserve the right to petition under 37 C.F.R. § 1.144. In particular, applicants respectfully request reconsideration and withdrawal of the Restriction Requirement to allow prosecution of all claim groups in the present application, for the reasons provided below.

According to Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the

Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803).

Applicants respectfully submit that all claim groups as designated by the Examiner do not warrant separate examination and search. Claims of each claim group call for the common chemical compound 2-methylheptylisonicotinate. Thus, the search and examination of all claim groups can be made jointly without increasing the burden on the Examiner. Applicants therefore respectfully request examination of all claim groups in this application.

Claims of Group II Should Be Rejoined

The applicants reserve their right to rejoinder of the non-elected claims prior to a notice of allowance for the elected claims of group I to the product in accordance with the guidance given by the Commissioner of Patents and Trademarks in 1184 OG 86. See *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996). See also MPEP 821.04, which states,

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP Section 806.05(f) and Section 806.05(h). The claims

to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. See MPEP Section 809.02(c) and Section 821 through Section 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

It is apparent that the process claims of Group II include the limitations of the elected product claims, and, thus, if the compound claims are found allowable, rejoinder should be permitted prior to a notice of allowance.

Further, if the claims of Group I are found to be patentable, then the claim of Group III should also be rejoined as it also contains the compound of Group I. In view of these considerations, the non-elected claims are not cancelled.

Therefore, in view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone

number indicated below.

Respectfully submitted,

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